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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,807	07/17/2003	Arthur M.P. Dowejko	D0250 NP	1455
23914	7590	09/19/2007		
LOUIS J. WILLE BRISTOL-MYERS SQUIBB COMPANY PATENT DEPARTMENT P O BOX 4000 PRINCETON, NJ 08543-4000			EXAMINER NASHED, NASHAAT T	
			ART UNIT 1656	PAPER NUMBER
			NOTIFICATION DATE 09/19/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/621,807	Applicant(s) DOWEYKO ET AL.	
	Examiner Nashaat T. Nashed, Ph. D.	Art Unit 1656	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-15, 17-27 and 29-39 is/are pending in the application.
- 4a) Of the above claim(s) 2, 3, 11-15, 17-26, and 30-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 5-10, 27 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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The application is amended as requested in the communication filed June 22, 2007. Accordingly, claims 1, 5, 6, and 29 are amended, and claim 16 is canceled.

Claims 1, 5-10, 27, and 29 are under consideration in this Office action.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1, 5-10, 16, 27, and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following are the reasons for the rejections:

- (a) The phrase "any part of" in claims 6(b) renders the claim indefinite because the resulting claim does not define the metes and bound of the claimed invention. Any part of the cavity reads on one atom. It is not possible to dock a chemical entity to one atom.

In response, applicants have amended claims 1, 5, 6, and 29 to overcome the above rejection, but they have missed the phrase in claim 6, part (b).

- (d) Claims 7-10 are included in with these rejection because the claims are dependent on a rejected claim and do not cure its deficiencies.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5-10, 16, 27, and 29 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US patent 6,965,850 ('850) for the reasons set forth in the prior Office action mailed 12/20/06.

In response to the above rejection, applicants argue that the site II disclosed in the '850 is not the same as that of the instant claims. Applicants indicate that the site II of the instant application is on the other side of the molecule from that described in the '850 patent.

Applicants' arguments filed 6/22/07 have been fully considered, but they are found unpersuasive. As indicated in the previous Office action that site II of the instant application and that taught in the '850 patent have considerable overlap, specifically, residues 570-577 and 598-600. Thus, it would be hard to imagine that the two sites are located on opposite side of the molecule. Applicants have not provided any evidence other than their argument that the amino acid residues are different. Since the examiner cannot determine whether the activator binding site taught in the '850 patent is identical to that of site II or not and the activator could contain other residues that are not taught in the patent, applicants have the burden of providing evidence of record to distinguish site II from that of the activator binding site. An example of the evidence would be a picture of the 3-D structure showing the activator binding site and site II of the instant application. With regard to the different atomic coordinates, atomic coordinates are non-function descriptive material (see the trilateral report), and thus, would not render a known method in the prior art novel and nonobvious.

Claims 1, 5-10, 27, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 00/52050 ('050, IDS reference AM filed 9/28/05) in view of US patent 5,856,116 ('116, IDS reference 1A) for the reasons set forth in the prior Office action mailed 12/20/06.

Claims 1, 5-10, 27, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2005/0181362 ('362) for the reasons set forth in the prior Office action mailed 12/20/06.

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Claims 1, 5-10, 16, 27, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2005/0181362 ('362) in view of 6,965,850 ('850, Baxter *et al.*).

In response to the above rejection, applicants argue that the prior art does not teach the claimed subject matter and structure coordinates are not disclosed in either '050 or '116.

Applicants' arguments filed 6/22/07 have been fully considered, but they are found unpersuasive. The examiner agrees with the applicants with regard of the teachings of the two documents, but, as indicated in the prior Office action, atomic coordinates are non-functional descriptive material. Non-functional descriptive material would not render a known or obvious method novel. The prior art discloses the presence of two ligand-binding sites. Applicants have provided no evidence to show that their site is not obvious over the prior art.

No claim is allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nashaat T. Nashed, Ph. D. whose telephone number is 571-272-0934. The examiner can normally be reached on MTWTF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathleen K. Bragdon can be reached on 571-272-0931. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nashed/

Nashaat T. Nashed, Ph. D.

Primary Examiner

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